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Amendment Under 37 C.F.R §1.116
Expedited Procedure – Art Unit: 1731

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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17-31

#10/16M
328-13

In re application of:

Hans-Heinrich MÜLLER et al.

Appl. No. 09/888,651

Filed: June 26, 2001

For: APPARATUS FOR ADVANCING
STREAMS OF PARTICLES OF
SMOKABLE MATERIAL

Art Unit: 1731

Examiner: Dionne A. Walls

Atty. Docket No. 31512-172587

Customer No.



26694

PATENT TRADEMARK OFFICE

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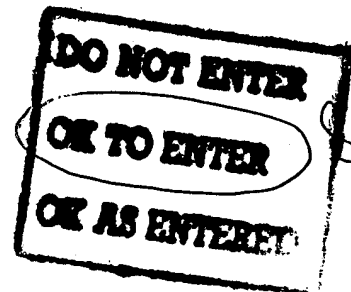
Request for Reconsideration

Honorable Commissioner for Patents
Box AF
Washington, D.C. 20231

Sir:

In reply to the Office Action dated December 26, 2002, Applicants submit the following
Reply.

No fees are required. However, if the Patent Office deems that any fees are necessary,
authorization is hereby granted to charge any required fees Deposit Account No. 22-0261.



DAW
4-5-03

Applicants: Hans-Heinrich MÜLLER et al.
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Remarks

Reconsideration of this Application is respectfully requested.

Claims 1-16 are pending in the application, with claims 1 being the independent claim.

Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

New Matter Objection

In item 1 of the Action, the Examiner objects to the substitution of “tungsten carbide/cobalt” for “tungsten carbide” on page 12 of the specification, as amended in the Amendment filed October 3, 2002. Submitted herewith is a Certificate / Declaration from a translator certifying the accuracy of the corrected translation. Withdrawal of the objection is respectfully requested.

Rejections under 35 U.S.C. § 103

Claims 1-6, 9, 10 and 15 stand rejected under 35 U.S.C. §103 as being unpatentable over Applicant's Admitted Prior Art (“AAPA”) in view of U.S. Patent 5,290,507 to Runkle.

Claim 1 recites that “at least one of said walls consisting at least in part of a ceramic material.” As teaching this feature, the Action argues the following: 1) the AAPA admits that tungsten/carbide cobalt is used as a coating on the walls, 2) Runkle teaches the use of tungsten

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carbide (a ceramic) as a wear resistant material, and 3) it would be obvious to substitute the tungsten carbide cobalt with tungsten carbide because of its wear resistance.

Reconsideration is respectfully requested. As noted by the Examiner, Runkle states “carbide compositions (carbides), for example tungsten carbide (a ceramic) or the cemented tungsten carbide cobalt (a cermet) have outstanding wear resistance.” However, immediately following this statement, Runkle continues: “However, these carbides are usually too brittle to be used as structural elements (which must possess the ability to withstand impact). Furthermore, wear resistant materials (such as carbides) typically are more costly than common alloy steel. As well, cemented carbides, due to their brittleness and lower coefficient of thermal expansion cannot be metallurgically clad or bonded to large steel substrates without great difficulty of expense.”

Thus, one skilled in the art would not use the carbides listed in Runkle for a material to be clad or bonded to the steel substrate of the tobacco duct in the present invention. The above-cited passage would actually *discourage* one skilled in the art from using a ceramic. As stated by the Federal Circuit, “[a] reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered.” *Bausch & Lomb, Inc. v. Barnes-Hind/Hyrdocurve, Inc.*, 230 USPQ 416 (Fed. Cir. 1986)

The teachings of Runkle state that the carbide material cannot be bonded to steel substrates. Even though claim 1 does not require steel substrate in the tobacco duct, it is important to note that the rejection cites the Applicants' prior art, which does use steel paneling.

Accordingly, one skilled in the art would not think to use the teachings of Runkle in conjunction with the prior art discussed by the Applicants.

Accordingly, it is respectfully submitted that claim 1 distinguishes over Runkle and AAPA and is allowable. Claims 2-6, 9, 10 and 15 depend from claim 1 and are allowable as depending from an allowable claim.

Claim 8 is rejected under 35 U.S.C. §103 as being unpatentable over AAPA in view of Runkle and GB 885,485. Claim 8 depends from claim 1. GB 885,485 fails to cure the deficiency of the rejection of claim 1, discussed above. As such, claim 8 is allowable as depending from an allowable claim.

Claims 1-5, 7, 9-11, 13-15 are rejected under 35 U.S.C. §103(a) as being unpatentable over DE 197 33 443 in view of AAPA and Runkle

AAPA and Runkle are cited for the same teachings as in the rejection of claims 1-6, 9, 10 and 15 discussed above. Claim 1 is allowable over the combination of DE 197 33 443, AAPA and Runkle for the reasons stated above. Claims 2-5, 7, 9-11, 13-15 depend from claim 1 and are allowable as depending from an allowable claim.

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Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

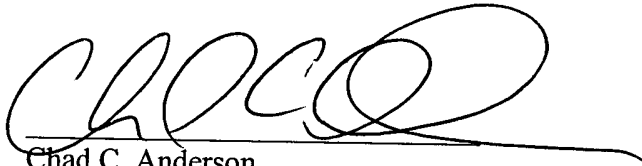
If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided.

A Notice of Allowance with claims 1-16 is respectfully requested.

Respectfully submitted,

Date: _____

03/26/03



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Certificate / Declaration

Commissioner for Patents
Washington, D.C. 20231

Sir:

I, Isolde U. Wasley, hereby declare that I am familiar with the English and German languages and am a professional translator from German into English. I am employed as a translator in the office of VENABLE, 1201 New York Avenue, N.W., Suite 1000, Washington, DC 20005-3917.

I have read the applicable portion of German priority document 100 30 296.3 in its original German and in its English translation. The English language specification contains an error on page 5, line 12 which occurred during translation from the German original. The term in the German priority document “Wolframkarbid/Kobalt” should be translated as “tungsten carbide/cobalt” instead of the incorrect “tungsten carbide.”

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I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statement are punishable by fine or imprisonment, or both, under §1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application of any patent issued thereon.

Date: 03.26.2003

Isolde U. Wasley
Isolde U. Wasley